REMARKS

I. Status of the Claims

Claims 1-122 are pending. Without prejudice or disclaimer, claims 1-3, 5-9, 13, 20, 27-29, 31-35, 39, 46, 54, 60-62, 64-68, 72, 79, 89-91, 93-97, 101, 108, and 115-117 are amended herein. Specifically, claims 1, 27, 60, 89, and 115-117 are amended to recite that the at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt is present in an amount ranging from 5 to 60%. Claims 1-3, 5-9, 27-29, 31-35, 60-62, 64-68, 89-91, 93-97, and 115-117 are amended to replace the at least one non-volatile hydrocarbon oil with the at least one non-volatile ester oil. Claims 2, 28, 61, and 90 are amended to recite that the at least one non-volatile ester oil is chosen from linear fatty acid esters and polyesters of fatty alcohols. Claims 7, 33, 66, and 95 are amended to recite that the at least one non-volatile ester oil is present in an amount ranging from 5 to 60%. Claims 13, 39, 72, and 101 are amended to recite that the at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt is present in an amount ranging from 20 to 50%. Claims 20, 46, 79, and 108 are amended to recite that the at least one low-viscosity phenylsilicone oil is present in an amount ranging from 5 to 80%. Claim 54 is amended to delete di(1,1,1-trimethylolpropane) tetrastearate. New claims 118-122 recite that the ester of claim 1 is diisostearyl malate. Support for these amendments and new claims can be found in the specification and claims as-originally filed, *e.g.*, claims 6, 13, 32, 39, 65, 72, 94, and 101 and specification as-published (U.S. Patent Application Publication No. 2004/0126350 A1) at ¶¶ [0047], [0048], [0057]-[0061], and [0064]-[0067]. Thus, no new matter is presented.

Applicants respectfully acknowledge that the rejection of claims 1-118 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0017124 A1 to Agostini et al. ("Agostini") has been withdrawn. *See* Apr. 29, 2008, Office Action at 2.

II. Rejections Under 35 U.S.C. § 102

A. Arnaud

The Examiner maintains the rejection of claims 1-6, 10-13, 24-32, 36-39, 50-65, 69-72, 83-84, 86-94, 98-101, and 112-118 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,961,998 to Arnaud et al. ("Arnaud") for the reasons of record. *See* Apr. 29, 2008, Office Action at 2-5.

Applicants previously argued that Arnaud does not anticipate the claimed invention because, among other things, one skilled in the art would not have immediately envisaged the claimed invention (i.e., at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt and at least one non-volatile hydrocarbon oil having a molecular mass of more than 500 g/mol) from the long list of possible oils disclosed in Arnaud. *See* Mar. 24, 2008, Response at 25-29. The Examiner responds that the claimed oils would "hardly [have been] selected from a long list," and one skilled in the art would, therefore, have immediately envisaged the claimed phenylsilicone and hydrocarbon oils. *See* Apr. 29, 2008, Office Action at 5.

Applicants respectfully traverse the rejection for the reasons of record, but in order to advance prosecution, Applicants amended independent claims 1, 27, 60, 89, and 115-117 to recite that the at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt is present in an amount ranging from 5 to 60%

and the at least one non-volatile hydrocarbon oil having a molecular mass of more than 500 g/mol is at least one non-volatile ester oil.

In order to anticipate the claimed invention, Arnaud must clearly and unequivocally disclose the claimed composition to one of ordinary skill in the art "without any need for picking, choosing and combining various disclosures." *In re Arkley*, 455 F.2d 586, 587,172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). In other words, one of skill in the art must be able to "at once envisage" the invention as claimed. *See* M.P.E.P. § 2131.02.

Arnaud discloses that its composition "contains one or more oils containing an aromatic group," which can have a hydrocarbon-based or silicone based skeleton. *See* Arnaud, col. 3, lines 15-17. Arnaud explains that the oil containing an aromatic group is present from "1 to 99.8% by weight, preferably from 5 to 80%." *See id.* at col. 4, lines 42-44. Further, Arnaud discloses that its composition "contains one or more types of oil other than the oils containing an aromatic group," including "hydrocarbon-based and/or silicone-based and/or fluoro oils." *Id.* at col. 5, lines 21-24. Arnaud, however, does not provide any guidance for selecting an oil with a silicone-based skeleton present in an amount ranging from 5 to 60%.

Moreover, Arnaud provides a laundry list of oils that can be used, including hydrocarbon-based oils of animal origin, hydrocarbon-based plant oils, linear or branched hydrocarbons of mineral or synthetic origin, synthetic esters and ethers, fatty alcohols, partially hydrocarbon-based and/or silicone-based fluoro oils, silicone oils, and mixtures thereof. *See id.* at col. 5, line 26 – col. 6, line 4. Further, in its long list of possible oils including silicone oils, volatile hydrocarbon oils, and volatile silicone oils,

Arnaud also teaches non-volatile hydrocarbon oils having a molecular mass of less than 500 g/mol. Arnaud, however, does not provide any guidance for selecting at least one non-volatile ester oil having a molecular mass or more than 500 g/mol to the exclusion of the other possible components.

Finally, while Arnaud does not preclude the possibility of the disclosed composition containing both a hydrocarbon-based oil and silicone-based oil, Arnaud provides no preference for this combination and all of the disclosed examples contain either a hydrocarbon-based oil or a silicone-based oil, but never the combination of the two. *See* Arnaud at Examples 1-8. Accordingly, one skilled in the art would have had to pick and choose to arrive at the claimed composition, which comprises, among other things, both at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt and at least one non-volatile ester oil having a molecular mass of more than 500 g/mol.

For at least those additional reasons, one skilled in the art, therefore, would not "at once envisage" the claimed invention. Thus, Applicants respectfully submit that this rejection should be withdrawn for at least these additional reasons.

B. Agostini

The Examiner maintains the rejection of claims 1-7, 10-33, 36-52, 54-66, 69-84, 86-95, and 98-118 under 35 U.S.C. § 102(e) as allegedly anticipated by Agostini. *See* Apr. 29, 2008, Office Action at 5-8.

Applicants previously argued that Agostini does not anticipate the claimed invention because, among other things, (1) Agostini does not provide any preference for adding a rheological agent to the second composition; and (2) Agostini does not provide

any preference for limiting the amount of volatile oil present in the second composition to less than 5% by weight, as claimed. *See* Mar. 24, 2008, Response at 29-31. The Examiner responds that "Agostini teaches that a rheological agent can be added to the second composition." Apr. 29, 2008, Office Action at 8. The Examiner further argues that the volatile liquid phase is an optional component of the second composition of Agostini, and, therefore, could be within the claimed range. *See id.*

Applicants respectfully traverse this rejection for the reasons of record, but in order to advance prosecution, Applicants amended independent claims 1, 27, 60, 89, and 115-117 to recite that the at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt is present in an amount ranging from 5 to 60% and the at least one non-volatile hydrocarbon oil having a molecular mass of more than 500 g/mol is at least one non-volatile ester oil.

In order to anticipate the claimed invention, Arnaud must clearly and unequivocally disclose the claimed composition to one of ordinary skill in the art "without any need for picking, choosing and combining various disclosures." *In re Arkley*, 455 F.2d 586, 587,172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). In other words, one of skill in the art must be able to "at once envisage" the invention as claimed. *See* M.P.E.P. § 2131.02.

Agostini discloses a second composition that contains "a second physiologically acceptable medium and a second coloring agent," and, preferably, a non-volatile liquid phase, which may be a hydrocarbon-based phase, fluoro phase and/or silicone phase. *See id.* at ¶¶ [0149], [0150], [0152]. Agostini discloses a number of hydrocarbon-based compounds that may be used, only one of which is an ester, diisostearyl malate. *See*

id. at ¶ [0162]. Agostini also discloses that the silicone phase may be a phenylsilicone oil, but says nothing about how much of the phenylsilicone oil is present in the physiologically medium. *See id.* at ¶ 0181]. Accordingly, one skilled in the art would not immediately envisage a composition containing an ester and a high viscosity phenyl-silicone oil present in an amount ranging from 5 to 60%.

Further, Agostini merely mentions in passing that:

> the physiologically acceptable media for each of the first and second compositions . . . may comprise, in addition to the . . . nonvolatile liquid phase for the second composition, additional fatty substances that may be chosen from waxes, oil, gums and/or pasty fatty substances, that are hydrocarbon-based, silicone based and/or fluoro-based, of plant, animal, mineral or synthetic origin, and mixtures thereof.

Id. at ¶ [0248]. Applicants noted in their prior response that Agostini does not provide any preference for adding a rheological agent, as disclosed and claimed in the instant invention, to the second composition.

The Examiner, however, dismisses this point, arguing that "the relevance of this assertion is unclear as clearly Agostini teaches that a rheological agent can be added to the second composition." Apr. 29, 2008, Office Action at 8. Applicants agree that certain rheological agents may be added to the second composition. Agostini, however, does not provide any preference for adding such a rheological agent, and it would require one skilled in the art to pick and choose to arrive at Applicants' claimed invention, including the addition of a rheological agent.

Moreover, Applicants noted previously that Agostini mentions that the "physiologically acceptable medium of the second composition may also contain a volatile liquid phase . . . ." *Id.* at ¶ [0205]. Agostini, however, does not provide any

teaching for limiting the amount of volatile oil present in the composition to less than 5% by weight, as claimed. The Examiner responds that "clearly this component is optional in the second composition of Agostini, thus its amount can be essentially zero." Apr. 29, 2008, Office Action at 8. Applicants do not disagree, but the amount may also contain more than 5% of a volatile oil. Agostini simply provides no guidance whatsoever, and one skilled in the art would be required to pick and choose to arrive at Applicants' claimed invention, including the limitation of less than 5% by weight of a volatile oil.

Because Agostini does not clearly and unequivocally disclose the claimed composition to one of ordinary skill in the art as claimed, i.e., all limitations in one composition, and further, "without any need for picking, choosing and combining various disclosures" (*In re Arkley*, 455 F.2d at 587,172 U.S.P.Q. at 526), one skilled in the art would not "at once envisage" the claimed invention. *See* M.P.E.P. § 2131.02. Thus, Agostini does not anticipate the claimed invention, and Applicants respectfully submit that this rejection should be withdrawn for at least this reason.

III. Rejection Under 35 U.S.C. § 103(a)

A. Arnaud

The Examiner maintains the rejection of claims 1-118 under 35 U.S.C. § 103(a) as allegedly unpatentable over Arnaud for the reasons of record. *See* Apr. 29, 2008, Office Action at 9-12. Specifically, the Examiner incorporates the same reasoning that he set forth in the § 102 rejection. *See id.* at 11. Moreover, citing *KSR Int'l Co. v. Teleflex, Inc.*, the Examiner argues that the motivation to combine both a high and low viscosity phenylsiloxane is only one consideration, and that it would have been obvious to combine a high and low viscosity phenylsiloxanes because "they were disclosed as

being used for the same purpose and the addition would not change the respective functions of the oils within the composition." *Id.* at 11-12.

Applicants respectfully traverse for the reasons of record and for at least the following additional reasons.

Applicants agree that "motivation is not the only consideration when determining obviousness" (Apr. 29, 2008, Office Action at 11-12), however, the Supreme Court, in the recent *KSR* case, recognized that a showing of "teaching, suggestion, or motivation" could provide helpful insight in determining whether the claimed subject matter is obvious under § 103(a). *KSR*, 127 S. Ct. 1727, 1740-41, 82 U.S.P.Q.2d 1385, 1396 (2007). Here, the Examiner failed to establish a *prima facie* case of obviousness because the claimed invention as a **whole** would not have been obvious in view of Arnaud, when considered as a **whole**. Specifically, as discussed above, one skilled in the art would not have immediately envisaged the claimed invention without picking and choosing from the various disclosures of Arnaud, and one skilled in the art would not have been motivated from reading Arnaud to arrive at the claimed invention by selecting (1) at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, and (2) at least one non-volatile ester oil having a molecular mass or more than 500 g/mol. Arnaud simply provides no preference for choosing these particular ingredients in combination to the exclusion of the other possible components. Indeed, the Examiner acknowledges that "one of ordinary skill in the art **could** have selected applicants ingredients" from Arnaud. *See* Apr. 29, 2008, Office Action at 11 (emphasis added). Without a more definite

predilection for the claimed components in the claimed amounts, Applicants respectfully submit that the Examiner failed to establish a *prima facie* case of obviousness.

Applicants also demonstrated that the claimed combination of at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60% and at least one non-volatile ester oil having a molecular mass or more than 500 g/mol results in certain benefits as compared with comparative compositions containing only a high viscosity phenylsilicone oil and no non-volatile ester oil. Specifically, Applicants compared compositions according to the present invention (Example 4), which comprised phenyltrimethyltrisiloxane (a high viscosity phenylsilicone oil as-claimed) and diisostearyl malate (a non-volatile ester oil as-claimed), with three comparative compositions, which contained phenyltrimethyltrisiloxane (Examples 1-3) but no ester as-claimed. *See* Specification as-published at ¶¶ [0126]-[0130] and Table (1). Lipsticks containing the compositions were then prepared and subjected to various tests. *See id.* at ¶¶ [0131]-[0136]. The experiments demonstrated that "[t]he sticks of Examples 2 and 3 were judged to have poor deposition properties owing to an excessively soft consistency; the stick of Example 1 was adjudged to deposit well on the lips but to exhibit a loss of gloss over time." *Id.* at ¶ [0136]. In contrast, inventive Example 4 "was adjudged to deposit well and the film of composition was adjudged to be homogeneous and glossy." *See id.*

The results of the tests described in the specification, therefore, demonstrate the improvements associated with using the combination of at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an

amount ranging from 5 to 60% and at least one non-volatile ester oil having a molecular mass or more than 500 g/mol. These benefits are not recognized by Arnaud.

Moreover, in their prior response, Applicants argued that one skilled in the art would not have been motivated from reading Arnaud to use both high and low viscosity phenylsiloxanes in combination. In response, the Examiner argues that "it would have been obvious to combine a high and low viscosity phenylsiloxane from the disclosure of Arnaud since they were disclosed as being used for the same purpose and the addition would not change the respective functions of the oils within the composition." *See* Apr. 29, 2008, Office Action at 12. Applicants respectfully disagree.

Arnaud merely discloses a laundry list of phenylsilicones that may be used in the composition, but nowhere states using both a high and low viscosity phenylsiloxane in combination. Indeed, all of the examples of Arnaud disclose using either a high or low viscosity phenylsiloxane, but never in combination. *See* Arnaud at Examples 1-7. Indeed, the Examiner concedes that Arnaud "is silent on the use of a low and high viscosity phenylsiloxane in combination." Apr. 29, 2008, Office Action at 12. Accordingly, one skilled in the art would have not been motivated to use both a high and low viscosity phenylsiloxane in combination in a single composition.

Accordingly, for at least these additional reasons, Applicants respectfully submit that the rejection should be withdrawn.

B. Arnaud in view of Willemin

The Examiner maintains the rejection of claims 1-118 under 35 U.S.C. § 103(a) as allegedly unpatentable over Arnaud in view of U.S. Patent No. 6,592,855 to Willemin et al. ("Willemin"). *See* Apr. 29, 2008, Office Action at 12-14.

Applicants previously argued that the combination of Arnaud and Willemin does not render obvious the claimed invention because there would have been no motivation to combine the low viscosity phenylsiloxane of Willemin with the composition of Arnaud. *See* Mar. 24, 2008, Response at 34-35. However, the Examiner dismisses Applicants' arguments. Specifically, relying on *In re Kerkhoven*, 626 F.2d 846, 850, 205 U.S.P.Q. 1069, 1072 (C.C.P.A. 1980), the Examiner states that "it is generally considered to be prima facie obvious to combine two compounds such as the phenylsilicone oils of Arnaud and Willemin in order to form a composition that is to be used for an identical purpose." Apr. 29, 2008, Office Action at 13-14.

Applicants respectfully traverse for the reasons of record and for at least the following additional reasons.

Even assuming for the sake of argument that one skilled in the art would have been motivated to combine the low viscosity phenylsiloxane of Willemin (*see* Willemin, col. 2, lines 25-51) with the composition of Arnaud, which Applicants do not concede, Willemin does not cure the remaining deficiencies of Arnaud.

In particular, as discussed above, one skilled in the art would not have immediately envisaged the claimed invention without picking and choosing from the various disclosures of Arnaud, and one skilled in the art would not have been motivated from reading Arnaud to arrive at the claimed invention by selecting (1) at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60%, and (2) at least one non-volatile ester oil having a molecular mass or more than 500 g/mol. Willemin does not cure these deficiencies. For example, Willemin merely discloses a lengthy list of various fatty phase compounds

that may be included in the composition, but provides no preference for esters, as presently claimed.

Moreover, Applicants have also demonstrated that the claimed combination of at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60% and at least one non-volatile ester oil having a molecular mass or more than 500 g/mol results in certain benefits as compared with comparative compositions containing only a high viscosity phenylsilicone oil and no ester. Specifically, as discussed above, Applicants compared compositions according to the present invention (Example 4), which comprised phenyltrimethyltrisiloxane (a high viscosity phenylsilicone oil as-claimed) and diisostearyl malate (a non-volatile oil ester as-claimed), with three comparative compositions, which contained phenyltrimethyltrisiloxane (Examples 1-3) but no ester as-claimed. *See* Specification as-published at ¶¶ [0126]-[0130] and Table (1). For the same reasons discussed above, the results of the tests described in the specification demonstrate the improvements associated with using the combination of at least one high viscosity phenylsilicone oil having a viscosity greater than or equal to 500 cSt present in an amount ranging from 5 to 60% and at least one non-volatile ester oil having a molecular mass or more than 500 g/mol. These benefits are not recognized by Arnaud, nor by Willemin.

Accordingly, Applicants respectfully submit that the rejection is in error for at least these additional reasons and should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, he is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4152.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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